

REMARKS

Applicant has carefully considered the Examiner's Office Action, and has amended the base claim 1 only for the purpose of inserting clarifications because it appears that the Examiner has misunderstood applicant's invention.

Thus, the new inserted parts in the base claim 1 have already antecedent basis in the original part of the claim which has not been currently underlined.

Applicant is not introducing new issues into the base claim 1. Applicant is expressing only the phrases in the previous base claim 1 to provide for emphasis of the subject matter which the Examiner has misunderstood.

If in considering the present Amendment and the description of applicant's invention in conjunction with the drawings, and the Examiner finds that the base claim 1 is clear without the underlined portions in the present Amendment, then applicant will cancel these underlined portions if the Examiner deems this to be superfluous.

In considering the Examiner's comments when comparing applicant's invention in relation to the prior art, it is apparent to applicant that the Examiner has not fully understood the present invention.

Thus, the Examiner lists various elements that are present in the reference patent to Klinkner (4,685,698) and asserts that these elements are also present in applicant's invention.

However, such a listing of elements is not sufficient to show that applicant's claims read on this reference patent to Klinkner.

In considering fluid circuits, there are only a limited number of components available. However, there are an infinite number of ways to interconnection these components to provide advantageous functions and fluid flow structures that differ substantially from each other.

Whereas some of the components that are present in applicant's invention may also be seen in the reference patent to Klinkner, applicant provides a new fluid flow circuit that is not disclosed in the patent to Klinkner. A person working in the art, could not arrive at applicant's invention as well as the advantages available through applicant's arrangement, by having before him the reference patent to Klinkner.

It is only through applicant's structure and interconnections that the advantages available from applicant's invention may be arrived at.

Fluid flow circuits as dealt with in the present application, are similar to electrical circuits in the respect of having available a limited number of components but an infinite number of interconnections and functions provided by the various circuit interconnections. If this is not recognized, then only a handful of patents could be considered to anticipate all of the fluid and electrical circuits that may be invented.

Thus, the Examiner asserts in the Office Action that the component 4' shown in Figure 7, of the reference patent to Klinkner, is a constant bypass with constant flow cross-section. However, this is incorrect.

In column 7, line 13, of the reference patent to Klinkner, it is clearly described there that the component 4' is an "adjustable throttle" that is arranged in the bypass of the shock absorber. This feature is also designated by the arrow through the component 4 in the drawing. This arrow is the hydraulic symbol that designates the controllable throttle 4' to be adjustable.

Accordingly, the component 4' cannot be considered in any manner, whatsoever, to be a constant bypass with a constant flow through cross-section in the sense defined in claim 1 of the present Amendment.

The Examiner also considers that in Figure 7 of the reference patent to Klinkner, the reference numeral 4" which designates controllable valves in the shock absorber bypass to be the same as the flow regulating systems for the compression and decompression phases as defined by applicant's claim 1. This comparison is, however, also incorrect.

As clearly described in column 7, lines 9 to 18 of the reference patent to Klinkner, the controllable valves 4" are arranged in a bypass which surrounds the main damping piston of the shock absorber.

In applicant's invention, however, the flow regulating systems for the compression and decompression phases are not arranged in a bypass to the main damping piston, but they form, instead, the main flow channels through the main damping piston itself. It is apparent that the Examiner has not understood this part.

In applicant's invention, the controllable damping valves are the main damping valves of the damping piston themselves and they are not additional or auxiliary damping valves which are arranged in a bypass that is hydraulically parallel to the main damping piston.

The Abstract of the reference patent to Klinkner also describes clearly that a controllable bypass is provided, and that this controllable bypass connects the two chambers of the shock absorber. This may be clearly derived from the Abstract sentence "The damper preferable includes two chambers connected by a controllable bypass. A controllable throttle and/or valve is provided in the bypass to adjust the damping characteristic of the absorber."

In contrast to this reference patent to Klinkner, however, applicant's invention provides that the bypass between the two chambers is a constant and not controllable flow cross-section.

It is apparent from the preceding discussions, that the Examiner has not clearly understood applicant's invention. The

Examiner has taken individual components from the drawings of the reference patent to Klinkner and compared them to the present application, without considering the description portions associated with those components. Applicant's invention differs clearly from the reference patent to Klinkner.

Applicant is submitting also a sketch of Figure 7 of the reference patent to Klinkner, which includes a summary of a number of points expressed above.

In view of the aforementioned misunderstandings of the Examiner, applicant has amended the base claim 1 with the aim of providing further clarification so as to avoid these misunderstandings. As already noted supra, applicant will cancel the added material in base claim 1 if the Examiner deems that to be appropriate.

The Examiner has noted in the Office Action on page 2, point 1, that the section headings are missing in the specification. Applicant submits, however, that these section headings were included in the Amendment filed April 21, 2003.

The Examiner's attention is respectfully directed to the court decision in the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199). In that decision, the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

In the case of Panduit Corporation v. Burndy Corporation (180 U.S.P.Q. 498), the Court decided that inquiry into patentability must be directed towards subject matter as a whole and not to elements of combination and their individual novelty; combination which results in a more facile, economical, or efficient unit, or which provides results unachieved by prior

art structures, cannot be anticipated piecemeal by showing that elements are individually old.

In the case of *In re Bisley* (94 U.S.P.Q. 80, 86), for example, the Court ruled that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

Furthermore, in *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

Finally, in the case of *Menge and Drissen* (181 U.S.P.Q. 94), the Court decided that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

Since this case has now undergone seven Office Actions, a CPA, an Appeal, and two examiners, applicant wishes to request a telephone conference with the Examiner with the aim of reaching an agreement to hopefully place the application in condition for allowance.

At the same time, in view of the present clarifying amendment to the base claim 1, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Respectfully submitted,

By: Max Fogiel 3/19/05
Max Fogiel
44 Maple Court
Highland Park, NJ 08904
Phone: (732) 214-8892

c:\documents\fogiel\amendments\Preuschat 008895 amendment 10 3-14-05

PLEASE SEE NEXT PAGE 12